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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,376	08/21/2003	Volker Stade	11349-18-999	8582
20583	7590	07/02/2004	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			HAWKINS, CHERYL N	
			ART UNIT	PAPER NUMBER
			1734	
DATE MAILED: 07/02/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/646,376

Applicant(s)

STADE, VOLKER

Examiner

Cheryl N Hawkins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 10-18 is/are rejected.
- 7) ☒ Claim(s) 4-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Manusch et al. (US 6,105,650). Manusch et al. disclose a hand-held device for transferring a film (Figure 1, tape 7) from a backing tape (Figure 1, carrier tape 6) onto a substrate (Figure 1, substrate 8), the device comprising a housing in which a supply of the backing tape is arranged (column 5, lines 36-39); and an application member (Figure 1, applicator foot 3) projecting from the housing and having a front end with a free end and at least a first application edge (Figures 1-3, application toe 4a) and a second application edge (Figures 1-3, application toe 4b), the backing tape being wound around the free end and the application edges of the application member and extending into the housing with tape sections at a lower longitudinal side facing the substrate during the mode of operation and at an upper longitudinal side opposite the lower longitudinal side; wherein the second application edge projects from the lower longitudinal side of the application member.

3. Claims 1 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Manusch et al. (US 4,853,074). Manusch et al. disclose a hand-held device for transferring a film (Figure 3a, film 5a) from a backing tape (Figure 3a, carrier tape 5) onto a substrate (Figure 3a, substrate 17),

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the device comprising a housing in which a supply of the backing tape is arranged (column 6, lines 40-42); and an application member (Figure 1, applicator element 4, applicator bar 14) projecting from the housing and having a front end with a free end and at least a first application edge (Figure 4b, pressure-application edge 14') and a second application edge (Figure 4d, heel edge 18), the backing tape being wound around the free end and the application edges of the application member and extending into the housing with tape sections at a lower longitudinal side facing the substrate during the mode of operation and at an upper longitudinal side opposite the lower longitudinal side; wherein the second application edge projects from the lower longitudinal side of the application member.

As to Claim 15, Manusch et al. disclose a hand-held device wherein the second application edge (Figure 4d, heel edge 18) is offset backwards in relation to the first application edge (Figure 4d, pressure-application edge 14') in a direction closer to the housing.

4. Claims 1-3, 10, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi (JP 11-157290). Kobayashi discloses a hand-held device (Figure 1, transfer utensil 1) for transferring a film (Figure 4, film 26) from a backing tape (Figure 4, carrier tape 25) onto a substrate (Figure 1, substrate 28), the device comprising a housing (Figure 1, case 2) in which a supply of the backing tape is arranged (Figure 1, supply reel 3); and an application member (Figure 10a and 10b, transfer head 5) projecting from the housing and having a front end with a free end and at least a first application edge (figure 10a, first pressing part 15) and a second application edge (Figure 10a, second pressing part 30), the backing tape being wound around the free end and the application edges of the application member and extending into the housing

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with tape sections at a lower longitudinal side facing the substrate during the mode of operation and at an upper longitudinal side opposite the lower longitudinal side; wherein the second application edge projects from the lower longitudinal side of the application member.

As to Claim 2, Kobayashi discloses a hand-held device wherein the application edges (Figure 10a, pressing parts 15 and 30) have mid-central planes enclosing an angle of approximately 30° to 120°.

As to Claim 3, Kobayashi discloses a hand-held device wherein the mid-central planes of the application edges (Figure 10a, pressing parts 15 and 30) enclose an angle of approximately 45° to 90°.

As to Claim 10, Kobayashi discloses a hand-held device wherein the housing has a lower border and a bottom side; and the second application edge extends beyond at least one of the adjacent lower border of the housing or the bottom side of the housing (Figure 1).

As to Claim 15, Kobayashi discloses a hand-held device wherein the second application edge (Figure 10a, second pressing part 30) is offset backwards in relation to the first application edge (Figure 10a, first pressing part 15) in a direction closer to the housing.

As to Claim 16, Kobayashi discloses a hand-held device wherein the first application edge (Figure 2, first pressing part 15) is the front end of a longitudinally extending shaft (Figure 2, plate-form member 17) of the application member.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manusch (US 6,105,650) or Manusch et al. (US 4,853,074) or Kobayashi (JP 11-157290) as applied to claim 1 above, and further in view of Poisson et al. (US 5,281,298). The references of Manusch, Manusch et al, and Kobayashi do not disclose a hand-held device wherein the application member has a front end portion movable upwards against an elastic restoring force. Poisson et al. disclose a hand-held device wherein the application member has a front end portion movable upwards against an elastic restoring force to enable the hand-held device to smoothly apply film sections onto a substrate regardless of irregularities in the substrate surface (column 3, lines 38-57). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the application member of Manusch, Manusch et al, or Kobayashi to include a front end portion movable upwards against an elastic restoring force as suggested by Poisson et al. to provide a device which smoothly applies a film onto a substrate regardless of irregularities in the substrate surface.

As to Claim 12, the references as combined (see Poisson et al.) disclose a hand-held device wherein the application member (Figure 3, applicator member 18, applicator bar 20) has a rear end portion fixedly held in the housing (Figure 3, planar surface 22, housing 12); and the application member is elastically flexible in a vertical direction in at least a partial area of its length (column 3, lines 38-57).

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7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Manusch (US 6,105,650) or Manusch et al. (US 4,853,074) or Kobayashi (JP 11-157290) as applied to claim 1 above, and further in view of Morinaga (US 5,772,840). Manusch, Manusch et al., and Kobayashi do not disclose a hand-held device wherein the application member is rotatably mounted about a swivel axis extending in the housing upwards against an elastic restoring force. Morinaga discloses a hand-held device wherein the application member is rotatably mounted about a swivel axis extending in the housing upwards against an elastic restoring force to allow slight rotation of the application member for efficiently applying tape while preventing accidental breakage of the tape (Figures 1 and 2, coil spring 32; column 3, lines 4-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the application member of Manusch, Manusch et al., or Kobayashi to be rotatably mounted about a swivel axis extending in the housing upwards against an elastic restoring force as suggested by Morinaga to allow for slight rotation of the application member for efficiently applying tape while preventing accidental breakage of the tape.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Manusch (US 6,105,650) or Manusch et al. (US 4,853,074) or Kobayashi (JP 11-157290) as applied to claim 1 above, and further in view of Kobayashi (JP 11-157290). Manusch, Manusch et al., or Kobayashi do not disclose a hand-held device further comprising at least one guiding web projecting backwards from a backside of the second application edge. It is well known and conventional in the tape dispenser art, as disclosed by Kobayashi (Figure 1, guiding webs 18), to provide the application member of a hand-held device with a guiding web projecting backwards

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from the backside of the application edge to control movement of the tape during operation of the dispenser. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the second application edge of Manusch, Manusch et al., or Kobayashi to include at least one conventional guiding web projecting backwards from a backside; projecting guiding webs being well established in the tape dispenser art for controlling the movement of the tape during operation of the dispenser.

9. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manusch (US 6,105,650) or Kobayashi (JP 11-157290) as applied to claim 1 above, and further in view of Morinaga (US 5,772,840). Manusch and Kobayashi do not disclose a hand-held device wherein the application member is formed with a necking. Morinaga discloses a hand-held device wherein the application member is formed with a necking which connects the application member to shaft in the housing which allows the application member to rotational movement (Figure 2, blade portion 30, base portion 33; column 3, lines 4-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the application member of Manusch or Kobayashi to be formed with a necking as suggested by Morinaga to connect the application member to a shaft in the housing which allows the application member to move in a rotational manner.

As to Claim 18, the references as combined discloses a hand-held device wherein the application member has a rear end closer to the housing than the front end; and the necking is formed at the rear end of the application member (Figure 2, blade portion 30, base portion 33).



***Allowable Subject Matter***

10. Claims 4-9 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

As to Claim 3, the prior art of record to Manusch (US 6,105,650), Manusch et al. (US 4,853,074), and Kobayashi (JP 11-157290) do not disclose or provide motivation for a hand-held device comprising a third application edge projecting from the lower longitudinal side of the second application member between the first application edge and the second application edge.

***Conclusion***

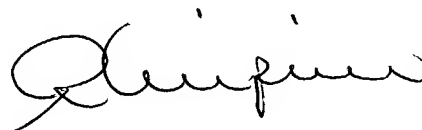
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl N Hawkins whose telephone number is (571) 272-1229. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (517) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Cheryl N. Hawkins* 6/27/04  
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June 25, 2004



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